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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,595	12/11/2001	Makoto Tabata	482842000500	4248

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EXAMINER
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VERBITSKY, GAIL KAPLAN

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<h2 style="margin: 0;">Office Action Summary</h2>	Application No. <b>10/009,595</b>	Applicant(s) <b>Tabata et al.</b>
	Examiner <b>Gail Verbitsky</b>	Art Unit <b>2859</b>
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<b>Period for Reply</b> <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b> <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Apr 1, 2002</u></p> <p>2a) <input type="checkbox"/> This action is FINAL.      2b) <input checked="" type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>		
<b>Disposition of Claims</b> <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1, 3-10, 13, 14, and 19-24</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) _____ is/are withdrawn from consideration.</p> <p>5) <input checked="" type="checkbox"/> Claim(s) <u>22-24</u> is/are allowed.</p> <p>6) <input checked="" type="checkbox"/> Claim(s) <u>1 and 19-21</u> is/are rejected.</p> <p>7) <input checked="" type="checkbox"/> Claim(s) <u>3-10, 13, and 14</u> is/are objected to.</p> <p>8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.</p>		
<b>Application Papers</b> <p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
<b>Priority under 35 U.S.C. §§ 119 and 120</b> <p>13) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a) <input checked="" type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p> <ol style="list-style-type: none"> <li>1. <input type="checkbox"/> Certified copies of the priority documents have been received.</li> <li>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</li> <li>3. <input checked="" type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> </ol> <p>*See the attached detailed Office action for a list of the certified copies not received.</p> <p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>		
<b>Attachment(s)</b> <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>2</u></p> <p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____</p>		

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## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119 (a)-(d).

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

3. Claims 6-8 are objected to because of the following informalities:

Claim 6: A) "the indicators" in lines 1-2 lacks antecedent basis because only "at least one indicator" has been positively claimed in claim 3,

B) "the reference plan" in line 2 lacks antecedent basis because no reference plan has been claimed in claim 3,

Claim 7: "the reference plan" in line 4 lacks antecedent basis because no reference plan has been claimed in claim 3,

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Claim 8: Perhaps applicant should replace “a back side” in line 4 with --the eardrum-- in order to clearly describe the invention. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Konno (U.S. 6386757B1).

Konno discloses in Figs. 2 and 7-8 an ear thermometer comprising a main body configured to be held by an operator, a probe attached to the main body and protruding from it and configured to be inserted into an ear canal of a patient, a start measuring switch 4 located on a substantially curved second side B opposite to a first side A. If to draw a plane C (reference plane) dividing the device into two symmetrical parts, the plane C will include a center axis D of the probe and also be a center of symmetry of the curved side wherein the curved surface of the

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curved side will be substantially constant along the length of the plane and perpendicular to the plane C. A center F of the curved surface is in the vicinity of a base G of the probe (the numerals A-G have been added by the Examiner, see attachment to the Office action).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Konno.

Konno discloses in Figs. 2 and 7-8 an ear thermometer comprising a main body configured to be held by an operator, a probe attached to the main body and protruding from it and configured to be inserted into an ear canal of a patient, a start measuring switch 4 located on a substantially curved second side B opposite to a first side A. If to draw a plane C (reference plane) dividing the device into two symmetrical parts, the plane will include a center axis D of the probe and also be a center of symmetry of the curved side wherein the curved surface of the curved side will be substantially constant along the length of the plane and perpendicular to the plane C. A center F of the curved surface is in the vicinity of a base G of the probe (the numerals A-G have been added by the Examiner, see attachment to the Office action).

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In a broad sense, as may be understandable from the figures, the operator can move his /her hand along the curved surface in order to chose (recognize) a comfortable position out of a plurality holding positions differing according to a direction in which the probe is being inserted (and the position of the patient, i.e., sitting, prone, supine, etc.). Konno states (col. 13, lines 26-28), that the switch 4 can have any shape (or any number of switches), thus, in a broad sense, suggesting the particular shape for allowing the operator to recognize a holding method (to determine the position of the hand of the operator relative to the switch) by touching the switch.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

#### *Allowable Subject Matter*

9. Claims 3-10, 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 22-24 are allowed.

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***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices.

12. Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (703) 306-5473 Monday through Friday 7:30 to 4:00 ET.

Any inquiry concerning this communication should be directed to the group receptionist whose telephone number is (703) 308-0956.

GKV

October 30, 2002

*Gail Verbitsky*

*G. Verbitsky*

*Patent Examiner, TC 2800*